



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/517,369

12/10/2004

Francis Pinault

Q84992

3960

23373 7590 08/04/2009  
SUGHRUE MION, PLLC  
2100 PENNSYLVANIA AVENUE, N.W.  
SUITE 800  
WASHINGTON, DC 20037

EXAMINER

NICKERSON, JEFFREY L

ART UNIT

PAPER NUMBER

2442

MAIL DATE

DELIVERY MODE

08/04/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/517,369	<b>Applicant(s)</b> PINAULT ET AL.	
	<b>Examiner</b> JEFFREY NICKERSON	<b>Art Unit</b> 2442	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 May 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 3-11, 14-22 and 28-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3-11, 14-22 and 28-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 May 2009 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. This communication is in response to Application No. 10/517,369 filed nationally on 10 December 2004 and internationally on 13 June 2003. The request for continued examination presented on 14 May 2009, which cancels claims 1-2, 12-13, provides change to claims 3-11, 14-22, adds claims 28-30, provides replacement drawings, and provides change to the specification, is hereby acknowledged. Claims 3-11, 14-22, and 28-30 have been examined.

#### ***Drawings***

2. Applicant's replacement drawings filed 14 May 2009 are accepted. All prior objections to the drawings are hereby withdrawn.

#### ***Claim Objections***

3. Applicant's RCE filed 14 May 2009 providing change to the claims is noted. The examiner graciously thanks applicant for clearing up the general form and interpretation issues surrounding the prior version of the claims. All prior objections to the claims are hereby withdrawn. However, new objections may appear below.

4. Claims 3-11 and 14-22 are objected to under 37 CFR 1.75(c) as being in improper form because they do not depend upon a preceding claim. Dependent claims must "refer back to" the claim upon which they depend from. See also MPEP § 608.01(n)II.

5. Claims 11, 22, and 30 are objected to under 37 CFR 1.75(c) as being in improper form because they are separated by a claim which does not also depend from the same claim. See MPEP § 608.01(n)IV. Normally this is not an issue, however, since applicant must cancel all the claims and re-enter them in order to overcome the objection in #4, the re-ordering of the relative numbering of current claims 11, 22, and 30 is requested.

6. Claims 3-11, 14-22, and 28-30 are objected to under 37 CFR 1.75(d)(1) because of an improper use of antecedent basis.

Regarding claims 28, this claim recites the limitations "the setup" (line 6), "the signaling data" (line 8), "the exchange of voice data" (line 9), "the first channel" (line 12), "the second channel" (line 12), and "the established connections" (line 14). There is insufficient antecedent basis for these limitations in the claim and correction is therefore required. For purposes of further examination these phrases will be considered to read "a setup", "a signaling data", "an exchange of voice data", "the first transmission channel", "the second transmission channel", and "the connection", respectively.

Regarding claims 29, this claim recites the limitations "the first channel" (line 12), "the second channel" (lines 12-13), and "the second network" (line 14). There is insufficient antecedent basis for these limitations in the claim and correction is therefore required.

Art Unit: 2442

For purposes of further examination these phrases will be considered to read “the first transmission channel”, “the second transmission channel”, and “the private second communication network”, respectively.

Any claims not explicitly addressed inherit the objections of their parent claim(s).

### ***Response to Arguments***

7. Applicant’s arguments filed 14 May 2009, with respect to the rejections under 35 USC 103(a), have been fully considered and are persuasive. Therefore, the rejections have been withdrawn. However new grounds of rejection may appear below.

### ***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 3-11, 28, and 30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in

Art Unit: 2442

the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Regarding claim 28, this claim recites a single means with no other means. It is therefore a single means claim and contains undue breadth, with respect to 35 USC 112, first paragraph. See *In re Hyatt*, 708 F.2d 712, 714-715, 218 USPQ 195, 197 (Fed. Cir. 1983). See also MPEP 2164.08(a).

Regarding claims 3-11 and 30, these claims do not add new means, therefore do not cure the deficiencies of their parent claim(s), and thus inherit the rejection of their parent claim(s).

11. Claims 3-11, 28, and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 28, applicant uses the terminology “means that” and function. It is therefore unclear whether applicant is intending to invoke 35 USC 112, sixth paragraph. For purposes of further examination the examiner will consider it not to be invoked.

Regarding claims 3-11 and 30, these claims inherit the rejection of their parent claim(s).

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 3-11, 14-22, and 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Riggins (US 6,766,454 B1), and in further view of Clark (US 5,490,251) and Katinakis et al (US 6,389,039 B1).

Regarding claim 28, Riggins teaches a communication server for making services offered by a private second communication network available to at least one terminal connected to a first communication network (Riggins: Figure 1, clients 114a-114g accessing services 110a-110d, via Global server 106), the communication server comprising:

control means that sends configuration data on a transmission channel to a terminal connected to the first network (Riggins: Figure 5, step 515; col 7, lines 56-66 provide for sending configuration/page data);

wherein the configuration data is sent as a function of a selected criterion (Riggins: Figure 5, steps 505-510; col 7, lines 43-56);

wherein the selected criterion is a setup of a connection by the terminal with the server using a selected primary identifier (Riggins: steps 505-510; col 7, lines 45-56);

wherein the server exchanges data over the transmission channel in accordance with a selected protocol (Riggins: col 1, lines 63 – col 2, line 2; col 8, lines 37-60);

wherein the configuration data enables the terminal to set up a connection with the server on the transmission channel (Riggins: Figure 5, steps 525-535; col 7, line 66 – col 8, line 15); and

wherein the connection makes at least some of the services offered by the private second communication network available to the terminal (Riggins: Figure 5, steps 538-540; col 8, lines 15-36).

Riggins does not teach wherein the transmission channel is a first transmission channel;

wherein signaling data is exchanged on the first transmission channel simultaneously with an exchange of voice data on a second transmission channel;

setting up a connection on the first transmission channel during a voice connection between at least two users on the second transmission channel; or

making services offered available to the terminal during the voice connection.

Clark, in a similar field of endeavor, teaches wherein the first transmission channel is a first transmission channel (Clark: abstract); and

setting up a connection on the first transmission channel (Clark: abstract).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teachings of Clark for sending data over a signaling channel. The teachings of Clark, when implemented in the Riggins system, will allow one of ordinary skill in the art to authenticate users over a signaling channel in an



telecommunications network. One of ordinary skill in the art would be motivated to utilize the teachings of Clark in the Riggins system in order to conserve network resources and practice the system in a telecommunications environment.

The Riggins/Clark system does not teach wherein data on another channel is being sent during a voice connection between at least two users on said second channel so as to make services available during said voice connection.

Katinakis, in a similar field of endeavor, teaches wherein data on another channel is being sent during a voice connection between at least two users on said second channel, so as to make services available during said voice connection (Katinakis: abstract, col 5, lines 16-22).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teachings of Katinakis for simultaneous voice and data transmissions. The teachings of Katinakis, when implemented in the Riggins/Clark system, will allow one of ordinary skill in the art to send authentication data over a signaling channel while a voice connection is using the main bearer channel. One of ordinary skill in the art would be motivated to utilize the teachings of Katinakis in the Riggins/Clark system in order to allow users to access both voice and data services simultaneously.

Regarding claim 3, the Riggins/Clark/Katinakis teaches wherein the control means effects an identification procedure before sending said configuration data (Riggins: Figure 5, step 510; col 7, lines 43-56).

Regarding claim 4, the Riggins/Clark/Katinakis system teaches wherein the server further comprises:

a memory in which secondary identifiers are stored (Riggins: Figure 9, item 945, all subitems);

wherein the control means sends to said terminal identification data which, once installed in said terminal, enables the automatic sending to said server of at least one secondary identifier stored in a memory of said terminal (Riggins: Figure 15; col 14, line 44 – col 15, line 27);

wherein the control means compares the received secondary identifier with identifiers stored in said memory and then to send said configuration data to said terminal if the identifiers are identical (Riggins: Figure 15; col 15, lines 12-27).

Regarding claim 5, the Riggins/Clark/Katinakis system teaches wherein said control means sends security data to the terminal after said configuration data (Riggins: Figure 6, item 615; col 8, lines 37-60).

Regarding claim 6, the Riggins/Clark/Katinakis system teaches wherein said secondary identifier represents the user of said terminal (Riggins: Figure 9, item 960; col 15, lines 1-11).

Art Unit: 2442

Regarding claim 7, the Riggins/Clark/Katinakis system teaches wherein said configuration data or said identification data constitutes a script or an applet (Riggins: abstract).

Regarding claim 8, the Riggins/Clark/Katinakis system teaches wherein said configuration data, in the event of activation by the user of the terminal prompts said user to provide at least one tertiary identifier and to send a registration request containing at least said tertiary identifier to said control means on the first channel (Riggins: Figure 14, 1405-1420; col 13, line 49 - col 14, line 15; Clark: abstract);

wherein memory stores said primary identifiers in corresponding relationship to at least one tertiary identifier (Riggins: col 15, lines 12-27);

wherein the control means, on the receipt of a registration request, sends to said configuration data a request for the transmission of at least one primary identifier associated with said terminal (Riggins: col 14, lines 44-67); and

wherein on reception of said primary identifier, compare the primary identifier and the tertiary identifier previously received to the identifiers stored in said memory in order to authorize or refuse said registration as a function of the result of this comparison (Riggins: Figure 14, col 14, lines 28-43).

Regarding claim 9, the Riggins/Clark/Katinakis system teaches wherein said configuration data, in the event of reception of a call request message from the first network by said terminal (Clark: col 6, lines 35-50), extracts certain information from

Art Unit: 2442

said message and sends that information to said control means via said first channel (Katinakis: abstract and col 5, lines 16-22 provide for bidirectional communication of any data over signaling); and

wherein said control means, on receipt of said information, processes it as a function of its content and then sends to said terminal on said first channel a message selected as a function of the processing applied and the information received (Clark: col 6, lines 56-65).

Regarding claim 10, the Riggins/Clark/Katinakis system teaches wherein said configuration data, after the terminal has been registered and in the event of an attempt by said terminal to call a remote terminal, inhibits access to the first network and sends information including at least the primary identifier of the remote terminal to said control means on said first channel (Riggins: Figure 14; col 13, line 49 – col 14, line 43; Clark: col 6, lines 9-20; col 6, lines 56-65);

wherein said control means, on receipt of said information, processes it as a function of its content and sends to said terminal on said first channel a message selected as a function of the processing applied and the information received; and comprising at least one call authorization or prohibition (Riggins: Figure 14, items 1430 or 1440; col 13, line 49 – col 14, line 43; Clark: col 6, lines 9-20; col 6, lines 56-65); and

wherein the information is to be displayed on the screen of said terminal, so that on reception of said message, said configuration data either removes the inhibition on

Art Unit: 2442

access to the first network with a view to setting up the call or prohibits the call (Riggins: Figure 14, item 1445; Figure 12; col 13, lines 10-30; col 13, line 49 – col 14, line 43).

Regarding claim 11, this server claim comprises limitations found within claim 9 and the same rationale of rejection is used, where applicable; and

wherein said control means process the information received from said terminal after registering the terminal (Riggins: Figure 15, items 1540, 1555; col 15, lines 12-27).

Regarding claims 14-22 and 29, these method claims comprise limitations corresponding to those of claims 3-11 and 28 and the same rationale of rejection is used, where applicable.

Regarding claim 30, the Riggins/Clark/Katinakis system teaches further comprising a gateway that manages information displayed on a display of the terminal during the voice connection and offers services to the terminal via the display (Riggins: Figure 9, item 975; col 10, lines 41-61; Katinakis: col 5, lines 15-29);

wherein a connection is a voice connection (Katinakis: abstract; col 5, lines 15-29); and

wherein the services offered are related to the circumstances of the connection (Riggins: Figure 5, items 525-540; col 7, line 66 – col 8, line 36).

***Citation of Pertinent Prior Art***

Art Unit: 2442

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Martin, JR et al (US 2004/0215711 A1) discloses an applet push content system for mobile devices.

b. Giroti et al (US 7,492,873 B2) discloses a simultaneous voice and data session system between users on different networks with authentication considerations.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JEFFREY NICKERSON whose telephone number is (571)270-3631. The examiner can normally be reached on M-Th, 9:00am - 7:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on (571)272-3868. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. N./  
Jeffrey Nickerson  
Examiner, Art Unit 2442

/Andrew Caldwell/  
Supervisory Patent Examiner, Art  
Unit 2442